



MS APPEAL BRIEF - PATENTS
Docket No.: 1163-0356P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Tatsuya MITSUGI

Application No.: 09/955,197

Confirmation No.: 8676

Filed: September 19, 2001

Art Unit: 2174

For: COMMUNICATION NETWORK SYSTEM

Examiner: R. F. Pitaro

APPEAL BRIEF TRANSMITTAL FORM

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Appeal Brief on behalf of the Appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on September 12, 2006.

☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27.

The fee has been calculated as shown below:

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☒ Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) - \$120.00.

☒ Fee for filing an Appeal Brief - \$500.00 (large entity).

Application No.: 09/955,197

Docket No.: 1163-0356P


☒ Check in the amount of \$620.00 is attached.

☐ Please charge Deposit Account No. 02-2448 in the amount of \$620.00. A triplicate copy of this sheet is attached.

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Dated: January 5, 2007

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Before the Board of Appeals

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APPEAL BRIEF

MS Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 5, 2007

Sir:

As required under § 41.37(a), this brief is being filed after the filing of the Notice of Appeal, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2), and any required petition for extension of time, if applicable, for filing this brief and fees related thereto, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

I.	REAL PARTY IN INTEREST.....	4
II.	RELATED APPEALS AND/OR INTERFERENCES.....	4
III.	STATUS OF CLAIMS	5
IV.	STATUS OF AMENDMENTS.....	5
V.	SUMMARY OF THE CLAIMED SUBJECT MATTER	5
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	7
VII.	ARGUMENTS.....	7
A.	The Rejection Under 35 U.S.C §102(b) Is Improper As The Britt and Whitledge References Fail to Teach Each and Every Feature of Independent Claim 1 and Dependent Claims 2-7, As Required	7
1.	Legal Basis.....	7
2.	Britt and Whitledge Fail to Disclose One or More Portal Servers and a Conversion/Formatting Server as Claimed.....	8
B.	The Examiner Fails to Provide Proper Motivation to Combine Teachingse	11
C.	Dependent Claims Are Not Anticipated By Britt of Whitledge	14
VIII.	CLAIMS.....	16
IX.	EVIDENCE.....	16

X.	RELATED PROCEEDINGS	16
XI.	CONCLUSION.....	16
	APPENDIX A.....	18
	APPENDIX B.....	22
	APPENDIX C.....	23



Application No.: 09/955,197

Docket No.: 1163-0356P

Page 4 of 23

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Tatsuya MITSUGI

Before the Board of Appeals

Application No.: 09/955.108

Confirmation No.: 8676

Filed: September 19, 2001

Art Unit: 2174

For: COMMUNICATION NETWORK SYSTEM

Examiner: Ryan F. Pitaro

APPEAL BRIEF ON BEHALF OF APPELLANT: Tatsuya MITSUGI

MS Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 5, 2007

Sir:

I. REAL PARTY IN INTEREST

The real party in interest for this application is the Assignee, Mitsubishi Denki Kabushiki Kaisha, Tokyo, Japan.

II. RELATED APPEALS AND/OR INTERFERENCES

There are no related appeals or interferences known to Appellant that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

The final Office Action dated June 12, 2006 rejects claims 1-5, 7-11 and 13 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Britt, Jr., (US 2002/0032785) in view of Whitledge (US Pat. No. 6,925,595) and claims 6 and 12 are rejected under 35 U.S.C. §103 (a) in view of Britt, Jr., Whitledge and Appellant's admitted prior art.

Independent claims 1 and dependent claims 2-7 are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

Amendments after Final were not submitted. Therefore all previously submitted amendments have been entered.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant notes that the following notation of the specification and Figures is purely exemplary and does not represent a complete exhaustion of where claimed features are described in the specification and figures.

The claimed invention is directed to a communication network system that improves upon the prior art by implementing a centralized content server (10) and separate conversion/formatting server (30) to service the needs of one or more portal servers (20), see Fig. 1. In the prior art, as discussed in Appellant's background section and in the cited references, the conventional portal servers perform each of the operations associated with content information transfer, content conversion and formatting while also communicating with the portal device. This means that each portal server must contain all content information and a conversion

formatting device. When a system contains multiple portal servers, this becomes inefficient because the transferring, converting and formatting of information presents a load on the portal server and slows communication. Further, as new device and formatting for those devices appear, each portal server must be updated, and thus become costly to maintain and operate. See page 3, line 11 through page 5, line 12 and page 13 line 23 through page 14, line 28 of Appellant's specification.

Appellant addresses these and other problems of the prior art by the features of the claimed invention. As recited in claim 1 each of the content server (10), one or more portal servers (20) and conversion/formatting server (30) perform specific functions, alleviating the need for one server to perform all functions. Furthermore, the conversion/formatting server is disposed in a communication link between the content server and one or more portal servers in order to facilitate the exchange of content information conversion and formatting for the multiple devices in communication with the multiple portal servers.

Fig. 1 illustrates the general arrangement of the communication network. Fig.1 is discussed in detail on pages 11-18 of the specification. Further, Fig. 2-5 discuss various different data conversion and formatting based on the general structure illustrated in Fig. 1 and represent alternative embodiments as recited in dependent claims 2-7. These embodiments can be found respectively on pages 18, 28, 33 and 39 of the specification.

In providing a system that frees the portal servers to focus on the task of interacting with the communication device, while providing a centralized conversion/formatting server and content server, the system is more dynamic and allows for greater efficiency in data exchange from the systems of the prior art.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Final Office Action provides the following ground of rejection for review on appeal:

- (a) Claims 1-5, 7-11 and 13 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Britt, Jr. (US 2002/0032785) in view of Whitledge (US Pat. No. 6,925,595)
- (b) Claims 6 and 12 are rejected under 35 U.S.C. §103 (a) in view of Britt, Jr., Whitledge and Appellant's admitted prior art.

VII. ARGUMENTS

A. The Rejection Under 35 U.S.C §103(a) Is Improper As The Britt and Whitledge References Fail To Teach Each And Every Feature Of Independent Claim 1 And Dependent Claims 2-7, As Required.

1. Legal Basis

For a Section 103 rejection to be proper, the combination of references must teach or suggest each and every claimed element. See MPEP 2143; MPEP 706.02

Thus, if the cited reference fails to teach or suggest, under section 103, one of the claimed elements, then the rejection is improper and must be withdrawn.

2. Britt And Whitledge Fail To Disclose One or More Portal Servers and A Conversion/Formatting Server As Claimed

Independent claim 1 recites a communication network made up of three distinct servers, a content server, one or more portal servers and a conversion/formatting server, each of which are separately located where the conversion/formatting server is disposed in a communication link between the content server and one or more portal servers. Each communication between the content server and portal server is first sent to the conversion/formatting server which converts the received data from the content server to the appropriate format for use by a display of a device in communication with a portal server. Thus, each recited server is separated from the other in the communication network and communication is performed in a specific process using each server. This arrangement is illustrated in Fig.1.

The Examiner relies upon Britt as the primary reference to teach the general structure defined in claim 1. Britt, however, teaches an all-purpose server, what Britt calls a portal server 110, that communicates with outside devices acting as a portal between the device and Internet site while also performing content conversion. The portal server is in direct communication with other network servers 130. A conversion module 920 is included within each portal server 110 and performs the conversion of data prior to sending the data to the other network servers. See paragraphs 34 and 35. Thus, Britt provides a system in which communication is directly performed through portal servers and conversion is performed directly at each portal server prior to distribution of the data.

As shown in Fig. 1, Britt's sysytem is constructed by a server 130 and a client 150 in order to present a client-server based architecture. See paragraph 16. The network server results in the

client-server based architecture as an element having a function to connect between the server and the client.

Further, as shown in Fig. 3, the system is constructed by a portal server 110 and Internet site 130, which are associated with a wireless computing device 150. The Internet site 130 performs processing as an access point for the wireless computing device 150. See paragraph 33. Thus, the Internet site merely connects to the wireless computing device 150 via the portal sever. This arrangement is shown as the client-server based architecture in Fig. 1. It is further described in paragraph 33 that the portal server 110 includes a content conversion module 920 and that the portal server carries out the conversion processing.

Appellant respectfully submits that Britt teaches that each portal server also performs conversion therein. Thus the conversion processing can only be performed for the data of that publication portal server. Nowhere in Britt does it teach a separate conversion/formatting server for communicating with one or more portal servers and a content server and thus the advantages noted above of Appellant's claimed system cannot be obtained.

The Examiner provides Whitledge to teach a conversion server since the Examiner asserts Britt does not explicitly teach such server. Whitledge teaches a system for content conversion of electronic data using data mining. Data elements are selected and are then converted in a suitable format for displaying on a user device. In Whitledge, a proxy server 14 requests documents from the network device 12. A content server 16 performs conversion of the documents to a suitable format for the network device 12. The proxy server 14 then sends the converted data back to the network device 12. See Fig. 1, columns 6, lines 31-62.

In Fig. 3 of Whitledge, a system is constructed by a network device 12 and a proxy server (optional ADMIN server and network device 40). The ADMIN server is optional as shown in column 9 of Whitledge, which states “an optional administrative server 42 is a server used to modify configuration files used by the proxy server 14.” The ADMIN server carries out modification of configuration of files used by the proxy server. Further, it is described that the proxy server requests the original electronic document from the network device 12. In addition, it is described in column 6, that “the content converter 16 can also be integral to proxy server 14.” Thus, the content converter 16 is regarded as an element that is added to the proxy server. Also, as shown in column 6, the content converter 16 is a software component. Therefore, the system of Whitledge is actually constructed by a network device 12 and a proxy server.

Whitledge teaches a content server which performs conversion of documents received from a user device via a proxy server and forwards this data to the proxy server which then forwards the data to the user’s device. Essentially, Whitledge teaches a content server which also performs the operation of converting data. Whitledge does not teach a separate conversion/formatting server as claimed by Appellant. Appellant’s conversion/formatting server is separate from the content server and the portal servers for a specific reason, namely to provide greater flexibility and content control, while also reducing the redundancy and necessary device configurations of the prior art.

Further, the claim language refers to a specific communication link between the conversion/formatting server and one or more portal servers and also between the conversion/formatting server and a content server. Appellant respectfully submits that the references do not teach the specific claimed interaction between a content server, conversion/formatting server and one or more portal servers. For example, claim 1 recites, *inter*

alia, “a conversion/formatting server disposed in a communication link between said contents server and said one or more portal servers, for converting contents information which said conversion/formatting server has acquired from said contents server into exchangeable contents information ... and transmitting the formatted contents information to one or more of said one or more portal servers.” It is evident from the claim language each server performs a specific task, which enables the dynamic relationship between the conversion/formatting server and multiple portal servers, which cannot be achieved by a single server performing both conversion, formatting and transmission of content information to various devices, as done in Britt and thus cannot be taught or suggested by Britt’s teachings. Moreover it is unreasonable to believe a conversion/formatting server is disposed between a contents server and the portal servers in Britt’s system when each portal server in Britt’s performs the conversion and formatting itself.

For at least the above noted reasons, Appellant submits that the Examiner has inaccurately interpreted the references in applying the rejection.

B. The Examiner Fails To Provide Proper Motivation to Combine Teachings

The Examiner alleges that Whitledge provides the teaching of a conversion server as claimed and states that motivation to combine Whitledge's teachings with Britt’s system is found in Britt, paragraph 51 which states “alternative embodiments of the invention may include numerous different servers (e.g., database servers, web servers, etc.), and/or mirrored servers distributed across the network.” The Examiner further states that it would have been obvious to one of ordinary skill “to combine the system of Britt with the individual network device of Whitledge.

Motivation to do so would have been to quicken response time by adding another server and allowing the servers to work as a multiprocessing system.” See page 3 of the Office Action.

Appellant submits that Britt teaches conversion of data within the portal servers themselves. There is no suggestion or teaching to modify Britt’s system to perform conversion outside the portals. This is similar to the prior art discussed in Appellant’s background section. The Examiner relies upon the statement that Britt’s system may include numerous different servers to suggest that Britt’s system would and could include a conversion server as claimed by Appellant. As noted above, the statement at paragraph 51 states “alternative embodiments of the invention may include numerous different servers (e.g. database servers, web servers, etc.).” This statement suggests that other servers could be included in the system, not that servers already making up the core infrastructure can be modified. This statement also suggests that Britt’s current network system is unchanged and that other servers may be added (included) to Britt’s current core system. In short, it does not teach or suggest modifying the portal servers themselves, therefore the portal servers in Britt’s system retain their conversion operation.

Further, the statement quoted above suggests including servers that perform different functions from that of the current servers in Britt’s system, e.g. database servers, web servers, etc. One of ordinary skill would not look to Britt’s system and suggest adding the content server of Whitledge which also performs conversion operations and include the content server of Whitledge in Britt’s system in which conversion is already performed by the portal servers.

Appellant respectfully submits that paragraph 51 of Britt does not state how servers are to be used, where they are to be implemented, why they would be implemented, why a conversion server is necessary when conversion is already performed at the portal servers, nor does it suggest

any of the above. In the instant rejection, the Examiner lacks any motivation to combine the teachings of the Whitledge reference with those of Britt. When making such a combination, a substantial modification and functionality of Britt's system necessarily needs to be made. With the Examiners current position, Britt's system would include multiple conversion operations at different locations. This doesn't make any sense based on what is taught by the references. One of ordinary skill in the art would not be inclined to make such a modification based on the teachings within Britt and Whitledge. Indeed, the modification proposed by the Examiner creates numerous technical difficulties which would not be readily resolved. Consequently, no *prima facie* case is made and the combination cannot appropriately be made in a rejection of Appellant's claims.

Appellant notes that Appellant is not asserting that Britt is a closed system. Obviously the system of Britt can be modified to include additional servers to perform functions not readily implemented by the system shown in Fig. 1 of Britt. However, the processing, conversion etc of data between a portal device, portal server and Internet site is already well established without any suggestions or teaching in Britt to change or modify this well established core processing. With that said, Appellant notes that it makes no sense to add additional conversion servers in Britt's system when conversion is already performed at the portal server 110. The addition of Whitledge's conversion server does not remove the conversion processing and formatting performed in Britt's portal server. Thus, there must be some suggestion or teaching to do so, otherwise the suggested modification doesn't read on the claimed limitations.

As stated previously above, the claim language refers to a specific communication link between the conversion/formatting server and one or more portal servers and also between the conversion/formatting server and a content server. Thus, even if Whitledge's teachings were

combinable, which Appellant contends they are not, the combination does not teach the specific claimed interaction between at least the three separately claimed servers. Furthermore, neither of the references teach or suggest a separate content server.

Further, although the statement relied upon in Britt asserts that various additional servers can be added to the system, this statement obviously was meant to encompass additional servers in support of the current system of Britt, as shown in Fig. 1, not the changing of the system shown in Fig. 1. Clearly, if as the Examiner asserts, this statement was meant to provide alternative arrangements to the current core system of Britt, then such would have been discussed in alternative embodiments. Moreover, this statement gives breath to what is intended by providing examples of the type of servers to which it is referring. This includes database servers, web server, etc, all of which provide different functions from those already discussed with regard to the core system of Britt as shown in Fig. 1.

Accordingly, Appellant respectfully submits that the Examiner has failed to provide proper motivation for combining the teachings of Britt and Whitledge to achieve the claimed features of independent claim 1.

C. Dependent Claims Are Not Anticipated By Britt of Whitledge

Dependent claims 2-7 each reference a specific relationship between the content server, conversion/formatting server and/or one or more portal servers. The claims each independently recite the actions performed by particular servers and the communication between each server. For example, claim 2 recites, *inter alia*, “said one or more portal servers provides an instruction for transmission of information to be browsed for by said conversion/formatting server... said conversion/formatting server ... formats the contents information in the predetermined format into

contents information suitable for display on the communication terminal equipment and transmits the formatted contents information to said one or more portal servers.” Thus, a clear separation between the portal servers and the conversion/formatting server is recited in the manner in which communication is transmitted between the various servers.

Each of dependent claims 2-7 recites variations on the manner in which communication is performed between the different servers, which Appellant contends is not taught by Britt or Whitledge or Appellant’s admitted prior art. However, although each dependent claim varies in its claim scope and should be viewed individually, the language of each dependent claim clearly unites in establishing distinct actions performed by individual portal servers, a conversion/formatting server and/or a content server which makes up the unique arrangement of Appellants claimed invention. This is evidenced by the recitation in each dependent of: “formats the contents information in the predetermined content format into contents information suitable for display on the communication terminal equipment and transmits the formatted contents information to said one or more portal servers.” This recitation clearly recites a direct relationship between different servers, not the same server performing multiple functions. Neither of the applied references teach this distinction between servers and communication between different servers performing distinct functions.

Thus, Appellant respectfully submits that the dependent claims 2-7 are improperly rejected. Thus, reversal of the rejection of these claims is respectfully requested.

VIII. CLAIMS

A copy of the claims involved in the present Appeal are attached hereto as Appendix A.

IX. EVIDENCE

There is no additional evidence pursuant to §§ 1.130, 1.131, or 1.132 and/or evidence entered by or relied upon by the examiner that is relevant to this appeal as noted in Appendix B.

X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, and thus, no copies of decisions in related proceedings are provided.

XI. CONCLUSION

The withdrawal of the outstanding rejections and the allowance of claims 1, 5, 6, 8, 9, 13-32 and 34-44 are earnestly solicited.

Application No.: 09/955,197

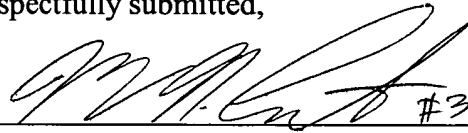
Docket No.: 1163-0356P

Page 17 of 23

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this paper and to credit any overpayment to Deposit Account No. 02-2448.

Dated: January 5, 2007

Respectfully submitted,



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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/955,197 are as follows:

Claim 1.

A communication network system that can provide contents information for users by way of a communication network, said system comprising:

a contents server disposed as a source of information, for storing contents information;

one or more portal servers, responsive to a request which a user makes through communication terminal equipment, for transmitting contents information to the communication terminal equipment; and

a conversion/formatting server disposed in a communication link between said contents server and said one or more portal servers, for converting contents information which said conversion/formatting server has acquired from said contents server into exchangeable contents information in a predetermined format, storing the exchangeable contents information in a memory, formatting the exchangeable contents information stored in said memory in the predetermined format into displayable contents information suitable for display on the communication terminal equipment in response to a request from said one or more portal servers, and transmitting the formatted contents information to one or more of said one or more portal servers.

Claim 2.

The communication network system according to Claim 1, wherein in response to a request for information browsing which a user makes through communication terminal equipment, said one or more portal servers provides an instruction for transmission of information to be browsed for by said conversion/formatting server, and said conversion/formatting server, in response to the information transmitter instruction from said one or more portal servers, converts contents information stored in said contents server into contents information in the predetermined format which can be browsed and stores it therein, and formats the contents information in the predetermined format into contents information suitable for display on the communication terminal equipment and transmits the formatted contents information to said one or more portal servers.

Claim 3.

The communication network system according to Claim 2, wherein in response to a request for information retrieval which a user makes through communication terminal equipment, said one or more portal servers provides an instruction for information retrieval for said conversion/formatting server, and said conversion/formatting server, in response to the information retrieval instruction from said one or more portal servers, retrieves desired contents information in the predetermined format which is stored therein, and formats the desired contents information in the predetermined format into contents information suitable for display on the communication terminal equipment and transmits the formatted contents information to said one or more portal servers.

Claim 4.

The communication network system according to Claim 1, wherein in response to a request for performance of a predetermined process which a user makes through communication terminal equipment, said one or more portal servers provides an instruction for the performance of the predetermined process for said conversion/formatting server, and said conversion/formatting server, in response to the instruction for the performance of the predetermined process from said one or more portal servers, converts contents information which is stored in said contents server into contents information which corresponds to the instruction for the performance of the predetermined process, and formats the resultant contents information into contents information suitable for display on the communication terminal equipment and transmits the formatted contents information to said one or more portal servers.

Claim 5.

The communication network system according to Claim 1, wherein in response to a request for performance of a predetermined process which a user makes through communication terminal equipment, said one or more portal servers provides an instruction for the performance of the predetermined process for said conversion/formatting server, and said conversion/formatting server, in response to the instruction for the performance of the predetermined process from said one or more portal servers, converts contents information which is stored in said contents server into contents information which corresponds to the instruction for the performance of the predetermined process, stores the resultant contents information

therein, and formats the resultant contents information into contents information suitable for display on the communication terminal equipment and directly transmits the formatted contents information to the communication terminal equipment according to event information added to the instruction for the performance of the predetermined process.

Claim 6.

The communication network system according to Claim 1, wherein said conversion/formatting server performs a formatting process so as to generate application data which defines a display format in which the communication terminal equipment can display contents information in the predetermined format transmitted thereto, and transmits the application data to said one or more portal servers as well as the contents information in the predetermined format.

Claim 7.

The communication network system according to Claim 1, wherein said conversion/formatting server performs a formatting process of formatting the contents information in the predetermined format into contents information which can be displayed on the communication terminal equipment, and transmits the formatted contents information to said one or more portal servers.

APPENDIX B

There is no additional evidence pursuant to §§ 1.130, 1.131, or 1.132 and/or evidence entered by or relied upon by the examiner that is relevant to this appeal.

Application No.: 09/955,197

Docket No.: 1163-0356P
Page 23 of 23

APPENDIX C

There are no related proceedings.